

Application Serial No. 10/645,574
Reply to Office Action dated December 19, 2004

REMARKS/ARGUMENTS

The outstanding Office Action sets forth a four-way restriction in the above-identified application. As filed, the application contains 21 claims, of which claims 1-19 are product claims and claims 20 and 21 are method claims. The application was specifically drafted with claims 2-13 being directed to a cutting head system and claims 14-19 being directed to a head cap. Claim 1 was drafted as a combination claim including all the particulars of the sub-combination claims 2-13 and 14-19.

With the above in mind, the Applicant respectfully traverses the restriction requirements between claims 1-19. More specifically, it is respectfully submitted that claim 1 links the sub-combination claims 2-13 and 14-19 such that restriction is improper. In particular, it is respectfully submitted that neither claim set 13-16 nor claim set 14-19 can be properly restricted from combination claim 1. In making the restriction requirement, the Examiner correctly identifies M.P.E.P. § 806.05(c). This section clearly specifies that supporting a requirement for restriction under combination/sub-combination requires two-way distinctness. That is, the inventions can be shown to be distinct only if: A) the combination as claimed does not require the particulars of the sub-combination; and B) the sub-combination can be shown to have utility either by itself or in other and different relations. The M.P.E.P. clearly states that when these factors are not shown, the inventions are not distinct such that restriction is not proper. In the present case, the Applicant would admit that the sub-combinations can have separate utility. However, combination claim 1 requires all the particulars of each sub-combination claims 2-13 and 14-19 such that claim 1 cannot be properly restricted from either of these claim sets. Specifically, combination claim 1 contains word-for-word, each of the limitations of claims 2 and 14.

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In attempting to restrict these claim sets, the Examiner relies upon example 3 provided in M.P.E.P. § 806.05(c). However, example 3 is not relevant in this situation. Example 3 concerns when multiple combination claims are presented such that some combination claims recite specific features of the sub-combination but other combination claims give evidence that the sub-combination is not essential to the combination. In the present case, there is only a single combination claim.

It is also interesting to note that the restriction requirement presented between the combination and sub-combination claims was not made utilizing the form paragraph for combination/sub-combination restrictions. This form paragraph specifically recites the criteria for distinctiveness and, as set forth above, specifically requires the combination as claimed to not require the particulars of the sub-combination as claimed. In view of the above, it is respectfully submitted that the Office Action does not set forth a proper restriction between claim 1 and claims 2-13 or claim 1 and claims 14-19. Instead, these restrictions cannot be properly made such that withdrawal of this separate groupings of claim 1, claims 2-13 and 14-19 is respectfully requested.

With withdrawal of this aspect of the restriction requirement, the Applicant would elect for initial prosecution the product claims 1-19. It is also submitted that it would not be unduly burdensome on the Examiner to also review method claims 20 and 21. However, if the Examiner continues to hold this restriction, the Applicant would elect, without traverse, the product claims for initial prosecution, while reserving the right to file a divisional application at a later time on the two method claims.

Based on the requirement of 37 C.F.R. § 1.143, the Applicant would elect for initial prosecution in this case claims 2-13 directed to the cutting head system. Again, it is respectfully submitted that claim 1 cannot be properly restricted from these claims, and claims 14-19 cannot properly be restricted from claim 1. If any type of restriction between the product claims is to be set forth in this application, it is respectfully requested that the Examiner provide a further justification for the restriction including a

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basis for restricting claim 1 from claims 2-13 as claim 1 clearly requires all the particulars of sub-combination claim 2.

Respectfully submitted,



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